



#43

Attorney Docket No: NVID001/00US

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Priem et al.

RECEIVED

Serial No.: 09/056,656

Examiner: Ulka J. Chauhan

JAN 05 2004

Filed: April 7, 1998

Art Unit: 2676

OFFICE OF PETITIONS

For: TEXTURE CACHE FOR A COMPUTER GRAPHICS ACCELERATOR

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop Petition
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

**PETITION UNDER 37 CFR § 1.182 FOR ACCEPTANCE OF DECLARATION
NOTWITHSTANDING NON-SIGNING INVENTOR**

Applicants are filing herewith a Declaration under 37 CFR § 1.131. By this petition under 37 CFR § 1.182, Applicants request that the Director accept the Declaration, notwithstanding fact of a non-signing inventor.

In particular, Applicants submit that co-inventors Gopal Solanki and David Kirk are persons qualified to submit the Declaration under 37 CFR § 1.131 (a) and 37 CFR § 1.47(a). Solanki and Kirk have made the necessary declarations on behalf of themselves and on behalf of Curtis Priem, and this petition establishes that co-inventor Curtis Priem refuses to sign the Declaration.

1. Pertinent Facts

NVIDIA CORP., the assignee of all rights in the subject application, has requested co-inventor Curtis Priem's assistance in reviewing and executing a Declaration under 37 CFR § 1.131 related to the subject application. Mr. Priem received the request for assistance, but refuses to join in prosecution of the application.

01/02/2004 SLUANG1 00000010 09056656

01 FC:1460

130.00 DP

2. Proof of Pertinent Facts

Applicants have enclosed the following documentary evidence:

- Exhibit 1 – Letter From Richard Domingo to Curtis Priem, dated December 1, 2003
- Exhibit 2 – Proof of Delivery to Curtis Priem on December 3, 2003
- Exhibit 3 – Proof of Delivery to Fred Weil (attorney representing Mr. Priem) on December 3, 2003
- Exhibit 4 – Reply Letter from Fred Weil to Thomas LaWer, dated December 16, 2003 (redacted, in part)
- Exhibit 5 – Declaration by Thomas LaWer in Support of the Petition, executed December 25, 2003

Exhibit 1 is proof that NVIDIA Corp. requested Mr. Priem's assistance in the prosecution of the subject application. Exhibits 2 – 4 are proof that Mr. Priem received the request for assistance. Exhibit 5 is proof that Mr. Priem refuses to join in prosecution of the subject application.

3. Fee

Applicants have enclosed a check believed to be sufficient to cover the petition fee set forth in 37 C.F.R. § 1.17(h). The Director is authorized to charge any shortage of fees that may be required under 37 C.F.R. §§ 1.16, 1.17, and 1.21 to Deposit Account 50-1283.



4. Last Known Address for Non-Signing Inventor:

Curtis Priem
4052 Kettering Terrace
Fremont, CA 94536

Mr. Priem may also be reached through his attorney:

Fred Weil
333 Market Street
23rd Floor
San Francisco, CA 94105-2173

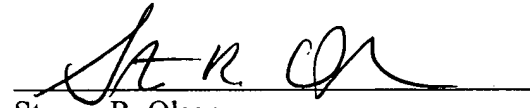
Dated: 12/30/03

Cooley Godward LLP
Attn: Patent Group
One Freedom Square - Reston Town Center
11951 Freedom Drive
Reston, VA 20190-5656
Tel: (703) 456-8000
Fax: (703) 456-8100

SRO:krf
Enclosures

Respectfully submitted,
COOLEY GODWARD LLP

By:


Steven R. Olsen
Reg. No. 48,174



NVIDIA.

December 1, 2003

VIA Federal Express

Mr. Curtis Priem
4052 Kettering Terrace
Fremont, CA 94536

Re: NVIDIA Patent Applications P000030, P000455, P000462, P000518

Dear Curtis,

I hope your Thanksgiving holiday was enjoyable.

I am sending along under cover of this letter a number of patent prosecution matters that we need and would appreciate your assistance on. Three of the matters (P000455, P000462, P000518) are patent applications for inventions that you made while at NVIDIA. These applications were prepared and filed as provisional applications in early 2003 with the expectation that you would be available later in the year to review. Drafts of these applications were sent to you earlier this year around September 12th. Upon completion of your review of the provisional applications, we will send you for your execution, the formal papers to be submitted to the U.S. Patent Office. The fourth matter (P000030) relates to a declaration that we would like you to execute in a pending application. The declaration would enable NVIDIA to swear behind a reference being asserted by the Examiner and possibly lead to allowance of that application. Please note that the declaration has already been executed by co-inventors David Kirk and Gopal Solanki.

As you are no longer an NVIDIA employee, and under the terms of Section 2d of your Proprietary Information and Inventions Agreement (copy enclosed), NVIDIA is more than willing to compensate you at a reasonable rate for your assistance. As we have never done this before during my time here, I'm proposing a rate of \$150 per hour for your assistance with a cap of 5 hours for the applications and 1 hour for the declaration. We hope that would be acceptable to you but are open to discuss with you what would be reasonable for your cooperation under Section 2(d).

Please note that we have the following non-extendible deadlines for providing the declaration and perfecting the provisional applications:

Application No. P000030: Declaration due January 2, 2004
Application No. P000462: Must be perfected by February 6, 2004
Application No. P000455: Must be perfected by March 27, 2004
Application No. P000518: Must be perfected by March 27, 2004

Again, we appreciate your assistance on these matters. I've been told many times that you were focused on your goal of developing the best patent portfolio for Nvidia and I am hoping we can count on your assistance on these applications to help further your goal. If you have any questions or concerns, please do not hesitate to contact me. My phone number is (408) 566-6481.

Very truly yours,



Richard B. Domingo
Director of Intellectual Property

cc: Fred B. Weil, Esq. HANSON BRIDGETT MARCUS VLAHOS RUDY, LLP
333 Market Street, 23rd Floor San Francisco, CA 94105-2173 (w/o enclosures)
Jensen H. Huang (w/o enclosures)
David M. Shannon (w/o enclosures)

Enclosures:

Declaration For Application No. P000030
Copy of Application No. P000462
Copy of Application No. P000455
Copy of Application No. P000518
Copy of Proprietary Information and Inventions Agreement

Olsen, Steven

EXHIBIT 2

From: Pamela Alvarez [PAvarez@nvidia.com]
Sent: Wednesday, December 03, 2003 3:49 PM
To: Rich Domingo
Subject: FW: FedEx shipment 791078068291

FYI:

-----Original Message-----

From: sysdeliv@fn3a.prod.fedex.com [mailto:sysdeliv@fn3a.prod.fedex.com]
Sent: Wednesday, December 03, 2003 12:29 PM
To: Pamela Alvarez
Subject: FedEx shipment 791078068291

Our records indicate that the shipment sent from PAMELA C ALVAREZ/NVIDIA CORPORATION to Mr Curtis Priem has been delivered. The package was delivered on 12/03/2003 at 11:29 AM and signed for or released by P.RIEM.

The ship date of the shipment was 12/02/2003.

The tracking number of this shipment was 791078068291.

FedEx appreciates your business. For more information about FedEx services, please visit our web site at <http://www.fedex.com>

To track the status of this shipment online please use the following:
http://www.fedex.com/cgi-bin/tracking?tracknumbers=791078068291&action=track&language=english&cntry_code=us

Disclaimer

FedEx has not validated the authenticity of any email address.

Track Shipments
Detailed Results**EXHIBIT 2** [Quick Help](#)

Tracking number 791078068291
Signed for by P.RIEM
Ship date Dec 1, 2003
Delivery date/Time Dec 3, 2003 11:29 am

Delivered to
Delivery location
Service type

Recipient
FREMONT CA
Standard Pak

Date/Time	Status	Location	Comments
Dec 3, 2003	11:29 am Delivered	FREMONT CA	No signature required - release waiver on file
	11:29 am Delivered	FREMONT CA	No signature required - release waiver on file
	8:11 am On FedEx vehicle for delivery	UNION CITY CA	
	5:45 am Arrived at FedEx Destination Location	UNION CITY CA	
Dec 2, 2003	9:44 pm Arrived at Sort Facility	OAKLAND CA	
	9:12 pm Left FedEx Origin Location	SANTA CLARA CA	
	6:58 pm Left FedEx Ramp	SAN JOSE CA	
	6:42 pm Arrived at FedEx Ramp	SAN JOSE CA	
	4:09 pm Picked up by FedEx	SANTA CLARA CA	

[Signature proof](#)[Track more shipments](#)

Email your detailed tracking results (optional)

Enter your email, submit up to three email addresses (separated by commas), add your message (optional), and click **Send email**.

From To

Add a message to this email.

[Send email](#)

From: Pamela Alvarez [PAvarez@nvidia.com]
Sent: Wednesday, December 03, 2003 5:13 PM
To: Rich Domingo
Subject: FW: FedEx shipment 792521782928

FYI:

-----Original Message-----

From: sysdeliv@fn3a.prod.fedex.com [mailto:sysdeliv@fn3a.prod.fedex.com]
Sent: Wednesday, December 03, 2003 2:12 PM
To: Pamela Alvarez
Subject: FedEx shipment 792521782928

Our records indicate that the shipment sent from PAMELA C ALVAREZ/NVIDIA CORPORATION to Fred B. Weil, Esq/Hanson Bridgett Marcus has been delivered. The package was delivered on 12/03/2003 at 12:56 PM and signed for or released by M.JUSTIN.

The ship date of the shipment was 12/02/2003.

The tracking number of this shipment was 792521782928.

FedEx appreciates your business. For more information about FedEx services, please visit our web site at <http://www.fedex.com>

To track the status of this shipment online please use the following:
http://www.fedex.com/cgi-bin/tracking?tracknumbers=792521782928&action=track&language=english&cntry_code=us

Disclaimer

FedEx has not validated the authenticity of any email address.

Track Shipments
Detailed Results**EXHIBIT 3**
 [Quick Help](#)

Tracking number 792521782928
Signed for by M.JUSTIN
Ship date Dec 2, 2003
Delivery date/Time Dec 3, 2003 12:56 pm

Delivered to
Delivery location
Service type

Receipt/Fmt desk
SAN FRANCISCO CA
Standard Envelope

Date/Time	Status	Location	Comments
Dec 3, 2003	12:56 pm	Delivered	SAN FRANCISCO CA
	8:00 am	On FedEx vehicle for delivery	SAN FRANCISCO CA
	7:34 am	Arrived at FedEx Destination Location	SAN FRANCISCO CA
	4:43 am	Left FedEx Sort Facility	OAKLAND CA
Dec 2, 2003	9:44 pm	Arrived at Sort Facility	OAKLAND CA
	9:12 pm	Left FedEx Origin Location	SANTA CLARA CA
	6:58 pm	Left FedEx Ramp	SAN JOSE CA
	6:42 pm	Arrived at FedEx Ramp	SAN JOSE CA
	4:09 pm	Picked up by FedEx	SANTA CLARA CA

[Signature proof](#)[Track more shipments](#)

Email your detailed tracking results (optional)

Enter your email, submit up to three email addresses (separated by commas), add your message (optional), and click **Send email**.

From
To

Add a message to this email.

[Send email](#)

FRED B. WEIL
Partner
DIRECT DIAL 415 995 5087
REPLY TO SAN FRANCISCO
E-MAIL fweil@hansonbridgett.com

EXHIBIT 4

HANSON
BRIDGETT

MARCUS
VLACHOS
RUDY-LLP

December 16, 2003

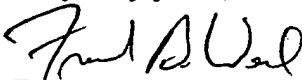
Thomas LaWer, Esq.
Cooley Godward LLP
Five Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306

Re: Curtis Priem

Dear Tom:

Finally, by letter dated December 1, 2003 from Richard B. Domingo, Director of Intellectual Property, Curtis was asked to provide services to the company regarding certain patent prosecution matters.

Very truly yours,


Fred B. Weil

cc: Mr. Curtis Priem

LAW OFFICES
WWW.HANSONBRIDGETT.COM

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1073083.1



EXHIBIT 5
PATENT

Attorney Docket No: NVID001/00US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Priem et al.

Serial No.: 09/056,656

Examiner: Ulka J. Chauhan

Filed: April 7, 1998

Art Unit: 2671

For: TEXTURE CACHE FOR A COMPUTER GRAPHICS ACCELERATOR

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

DECLARATION IN SUPPORT OF PETITION

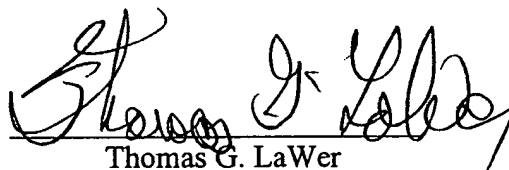
1. I am an attorney, licensed to practice law in the state of California. I represent NVIDIA Corporation (hereinafter "NVIDIA") in various legal matters.
2. I understand that Fred B. Weil (hereinafter "Mr. Weil") of Hanson, Bridgett, Marcus, Vlahos, & Rudy LLP represents Curtis Priem (hereinafter "Mr. Priem"), a former NVIDIA employee.
3. On behalf of NVIDIA, I received a December 16, 2003 letter from Mr. Weil with the subject line "Re: Curtis Priem." The letter from Mr. Weil did not contain any enclosures. I understand that a redacted version of that letter will be filed together with this Declaration.
4. I had a follow-up conversation with Mr. Weil via telephone on Thursday, December 18, 2003 at approximately 11:30 AM. In the course of that conversation, Mr. Weil indicated that



cooperation from Mr. Priem on patent prosecution matters related to NVIDIA is contingent on the resolution of certain unrelated disputes between Mr. Priem and NVIDIA. Because the unrelated disputes are outstanding, Mr. Priem is refusing to provide any assistance in the patent prosecution matters.

5. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Execution Date: 12-25-03


Thomas G. LaWer